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09/778,246	02/06/2001	David Langley	1211	6375

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EXAMINER

DUONG, FRANK

ART UNIT

PAPER NUMBER

2666

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Please find below and/or attached an Office communication concerning this application or proceeding.

SR

# Office Action Summary

Application No.

09/778,246

Applicant(s)

LANGLEY, DAVID

Examiner

Frank Duong

Art Unit

2666

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 06 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 February 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This Office Action is a response to the communication dated 02/06/01. Claims 1-23 are pending in the application.

#### ***Specification***

2. The abstract of the disclosure is objected to because it exceeds the length limitation of 150 words. Correction is required. See MPEP § 608.01(b).

#### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 1-23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-30 of U.S. Patent No. 6,252,855. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-23 encompass the claimed subject matters of claims 9-30 of the '855 patent. There is a difference in mere wording or omission of

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limitations between claims 1-23 of the instant application and the '855 patent.

Moreover, Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 9-30 of patent '855 teaches essentially the same steps/means as claims 1-23 of the current application. Even though claims 1-23 are broadened by omitting certain limitations (i.e., additional step of "*wherein the identifying ... calculating ... delays received*" in claim 9 of '855 patent has been omitted in claims 1-23 of the application), it has been held that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184(CCPA). Also note Ex parte Rainu, 168 USPQ 375 (Bd. App. 1969); omission of a reference element whose function is not needed would be an obvious variation.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Shikama et al. (USP 5513172).

Regarding **claim 1**, in according to FIG. 2, col. 8, lines 3-50, Shikama et al. (hereinafter "Shikama") discloses a method of frame handling with less latency of relay

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that reads on the claimed method of communicating at least one frame size in a frame relay network comprising:

identifying a first frame size (*at col. 8, lines 10-11, Shikama discloses the frame handler notifies the controller 25 of the frame length in header 8*); and

transmitting over a frame relay network a message (*a notice to the transmitter 23c of frame store time, see col. 8, lines 35-40*) having a size, said message responsive to the first frame size identified, wherein the first frame size is different from the size of the message (*at col. 8, lines 38-39, Shikama discloses the frame handler also notifies the controller 25 of the received logical link number in header 8. Then the controller determines the maximum frame length corresponding to the transmitting logical line number and input and output rates from the attribute table 32 (see FIG. 4, col. 7, lines 64-67 and col. 3, lines 48-53. Furthermore, at col. 8, lines 35-40, Shikama also discloses that a notice is transmitted to the transmitter 23c of the frame store time. It is inherent that a notice (signaling) has different frame size then the first frame size (maximum frame size). Therefore, the recitation thereat reads on the claimed limitation*).

Regarding **claim 2**, Shikama (*see col. 8, lines 45-50*) also discloses wherein the transmitting step is responsive to the first frame size exceeding a threshold as claimed.

Regarding **claim 3**, Shikama (*see col. 8, lines 13-16*) also discloses the transmitting step comprises transmitting the first frame size over a plurality of PVCs as claimed.

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Regarding **claim 23**, the claim calls for an apparatus having elements performing the functioning steps of claim 1. Thus, it is rejected by the same rationales applied in the rejection of claim 1.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shikama.

Regarding **claims 4-6**, the claims call for a computer program that performed the claimed limitations of claims 1-3 discussed above. Coding a program to instruct a computer to facilitate the controlling of a frame relay network is well known in the art. Therefore, it would have been obvious to those skilled in the art to code a computer program to perform the steps of the claimed method of claims 1-3 to facilitate the controlling of a frame relay network.

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6. Claims 7-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blasbalg (USP 4771391).

Regarding **claim 7**, in according to the abstract and FIGS. 1-4, col. 10, line 1 to col. 11, line 60, Blasbalg teaches a method of controlling the size of the packets transmitted by each node by monitoring the flow rate in the network and computing an average packet length based on a delay (col. 11, equation 3), then adjusting the length of the data field in each message frame. Even though Blasbalg's language is not the same as recitation in the claim. However, it is obvious to those skilled in the art that Blasbalg discloses the claimed limitations set forth in claim 7.

Regarding **claim 8**, in addition to the features discussed above, Blasbalg (see FIG. 2, col. 10, lines 53-55) further discloses the calculating step is responsive to a lowest value acceptable delay ( $N(p,x)=10$ ).

Regarding **claims 9-14**, see the abstract and col. 11, equations 3-3, wherein Blasbalg discloses the claimed limitations.

Regarding **claims 15-22**, the claims calls for a computer program performs the method of claims 7-14. It is obvious to those skilled in the art to implement a computer program code to perform the steps of the method of claims 7-14 to provide an automated network managing system. Therefore, by this rationale claims 15-22 are rejected.

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**Conclusion**

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bay Networks, Configuring Frame Relay to ATM Internetworking, pages 1-48, November 1996.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Duong whose telephone number is (703) 308-5428. The examiner can normally be reached on 7:00AM-3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Seema Rao can be reached on (703) 308-5463. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Frank Duong  
Examiner  
Art Unit 2666

July 25, 2004